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08/650,834 05/20/96 WREN

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1500 K STREET, N.W., SUITE 700
WASHINGTON DC 20005

TM02/0827

EXAMINER

KALINOWSKI, A

ART UNIT

PAPER NUMBER

2166

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08/27/01

28

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

GM

Office Action Summary

Application No.

08/650,834

Applicant(s)

Stephen C. Wren

Examiner

Alexander Kalinowski

Art Unit

2166

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jun 11, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-76 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-76 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 27 20) ☐ Other:

Art Unit: 2166

28

DETAILED ACTION

1. Claims 30-76 are presented for examination. Applicant filed an amendment on 4/21/2000 canceling claims 10-19 and adding new claims 20-29. Applicant further filed a continued prosecution application including a preliminary amendment on 6/13/2001 canceling claims 20-29 and adding new claims 30-76.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

The declaration fails to identify claimed priority to Application Serial Number 08/268,309 . The instant application is not co-pending with Application Ser. No. 08/264,184, 08/051,743 and 07/855,099. Therefore, Applicant's priority date for the claimed invention is the filing date of the instant application.

Art Unit: 2166

Specification

3. Claim 34 is objected to because of the following informalities:

a. In claim 34, line 1, replace "on" with --one--; and

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 30-76 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not describe in any specificity how the system comprises a computerized central communications facility that is adapted to be coupled to a plurality of other computerized central communications facilities and how a customer at a remote computerized facility requests to search a database at each of the computerized central communications facilities for information of interest or that a database of information on goods or services exists at the computerized central communications facilities.

Art Unit: 2166

6. Claims 39-41, 58, 61-63 and 73-76 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to disclose how software is downloaded to from the central communications facility to the computerized remote facility. The only description in the specification is that the software is downloaded but there is no discussion as to how this is accomplished. Therefore, the limitation will not be considered by the Examiner.

7. Claims 70-76 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosure does not provide support for a second communications device at a central communications facility associated with a second communications path for providing simultaneous digital communication between the central communications facility and said computerized remote facility.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2166

9. Claims 30-43 and 59-69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 30 and 59 include the use of the phrase "goods and/or services". The Examiner cannot determine the scope of the claim based on this phrase. Does the phrase require both goods and services or does the phrase require either goods or services? For purposes of applying prior art, the Examiner will interpret any instance of the phrase "goods or services" to mean goods or services.

10. Claim 54 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is directed to an apparatus. It is unclear to the Examiner how the type of goods or service further limits the claimed apparatus of claim 44. Since the types of goods or services does not provide a further limitation on a claim directed to an apparatus, the Examiner will not consider this limitation when applying prior art.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2166

12. Claims 30-37, 39-55, 57-65, and 67-76 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Agostino, Pat. No. 5,231,571 in view of Dworkin, Pat. No. 4,992,940.

As to claim 30, D'Agostino discloses an apparatus to market and sell goods and/or services over an electronic network (see abstract) comprising:

a computerized central communications facility adapted to be coupled to a plurality of other computerized central communications facilities and to a network, each of said computerized central communications facilities having information relating to goods or services stored in a database, and each of said computerized communications facilities having a processor programmed to (see Fig. 1 and col. 5, lines 64 - col. 6, line 35)

receive from a customer located at a computerized remote facility a request to search in the database at the computerized central communications facility for information of interest (col. 6, line 50 - col. 7, line 50 and col. 11, lines 22-29) and

provide said customer with live assistance upon request (col. 6, lines 50-53);

D'Agostino does not explicitly disclose

enable said customer to search said database for information of interest, direct a transmitter at said computerized central communications facility to transmit said information of interest from the database at said computerized central communications facility to said computerized remote communications facility; and

periodically update said database in said computerized central communications facility.

Art Unit: 2166

However, Dworkin discloses enabling said customer to search said database for information of interest, direct a transmitter at said computerized central communications facility to transmit said information of interest from the database at said computerized central communications facility to said computerized remote communications facility (col. 3, lines 60-69, col. 4, lines 35-61, and col. 5, lines 20). Dworkin further discloses periodically update said database in said computerized central communications facility (i.e. new product information)(col. 9, lines 36-47). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the features above as taught by Dworkin within D'Agostino in order to provide a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 31, D'Agostino does not explicitly disclose the apparatus of claim 30, wherein said computerized central communications facility is further programmed to facilitate a transaction between said computerized central communications facility and said computerized remote communications facility.

However, Dworkin discloses computerized central communications facility is further programmed to facilitate a transaction between said computerized central communications facility and said computerized remote communications facility (col. 2, lines 33-41 and col. 8, lines 9-37). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 30, wherein said computerized central communications facility is

Art Unit: 2166

further programmed to facilitate a transaction between said computerized central communications facility and said computerized remote communications facility as taught by Dworkin within D'Agostino in order to provide a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 32, D'Agostino does not explicitly disclose the apparatus of claim 30, wherein at least one of said computerized central communications facilities is further programmed to contact the customer and apprise said customer of goods and services offered or any special offerings.

However, Dworkin discloses wherein at least one of said computerized central communications facilities is further programmed to contact the customer and apprise said customer of goods and services offered or any special offerings (col. 9, lines 36-47). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 30, wherein at least one of said computerized central communications facilities is further programmed to contact the customer and apprise said customer of goods and services offered or any special offerings as taught by Dworkin within D'Agostino in order to alert the customer of any new products offered (col. 9, lines 36-47).

As to claim 33, D'Agostino discloses the apparatus of claim 30, wherein said computerized central communications facility and each of said other computerized central

Art Unit: 2166

communications facilities are associated with competing providers of goods and services (see Fig. 1 and col. 6, lines 30-40).

As to claim 34, D'Agostino discloses the apparatus of claim 30, wherein at least one of said computerized central communications facility and said other computerized central communications facilities further include an audio communication device for communication with said computerized remote communications facility (col. 6, lines 17-23).

As to claim 35, D'Agostino discloses the apparatus of claim 30, wherein said computerized central communications facility and at least one of said other computerized central communications facilities is further adapted to provide information relating to goods and services in the form of an audio or video presentation (col. 6, lines 17-23).

As to claim 36, D'Agostino does not explicitly disclose the apparatus of claim 35, wherein said apparatus further comprises means for recording a presentation stopping point for future reference.

However, the Examiner takes official notice that it was old and well known in the computer sales presentation arts to provide a stopping point in a user's presentation (i.e. saving a file which represents a potential transaction). This allows a user to resume a transaction at a later date without having to resubmit previously entered information. It would have been obvious to

Art Unit: 2166

one of ordinary skill in the art at the time of Applicant's invention to include means for recording a stopping point in the customer's last on-line presentation in case contact is resumed within D'Agostino and Dworkin in order to allow a customer to resume a transaction at a later date without having to resubmit previously entered information.

As to claim 37, D'Agostino discloses the apparatus of claim 30, wherein said processor is further programmed to compile a customer profile based on the customer's search of the database (col. 15, line 59 - col. 16, line 8).

As to claim 39, D'Agostino disclose the apparatus of claim 30, wherein said processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to present information of interest to said customer (col. 6, lines 17-29).

As to claim 40, D'Agostino discloses the apparatus of claim 30, wherein said processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to enable the customer to communicate with said central communications facility (col. 6, lines 17-29).

Art Unit: 2166

As to claim 41, D'Agostino does not explicitly disclose the apparatus of claim 30, wherein said processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to enable said customer to conduct a transaction using the information provided by said computerized central communications facility relating to goods and services.

However Dworkin discloses processor is further programmed to download software from said computerized central communications facility to said remote communications facility, said software adapted to enable said customer to conduct a transaction using the information provided by said computerized central communications facility relating to goods and services (Fig. 1, and col. 2, lines 20-41). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the features above as taught by Dworkin within D'Agostino in order to provide a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 42, D'Agostino discloses the apparatus of claim 30, wherein said processor is further programmed to provide an interactive presentation relating to goods and services (col. 6, lines 17-23 and lines 58-63).

As to claim 43, D'Agostino does not explicitly disclose the apparatus of claim 42, wherein said interactive presentation includes an audio presentation in the form of a computerized voice.

Art Unit: 2166

However, the Examiner takes official notice that it well known in the electronic sales presentation arts to have an interactive presentation includes an audio presentation in the form of a computerized voice. The purpose of computerized voice was to have a customer friendly sales presentation. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 42, wherein said interactive presentation includes an audio presentation in the form of a computerized voice within D'Agostino for the motivation stated above.

As to claim 44, the claim is substantially similar to claim 30 and is rejected on the same basis.

As to claim 45, the claim is substantially similar to claim 31 and is rejected on the same basis.

As to claim 46, the claim is substantially similar to claim 30 and is rejected on the same basis.

As to claim 47, D'Agostino does not explicitly disclose the apparatus of claim 44, wherein said central communications facility further or at least one of the other central communications facilities further provides a directory of providers of goods and services.

Art Unit: 2166

However, Dworkin discloses wherein said central communications facility further or at least one of the other central communications facilities further provides a directory of providers of goods and services (see Fig. 3, and col. 3, lines 65-69). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 44, wherein said central communications facility further or at least one of the other central communications facilities further provides a directory of providers of goods and services as taught by Dworkin within D'Agostino in order to provide a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 48, the claim is substantially similar to claim 35 and is rejected on the same basis.

As to claim 49, the claim is substantially similar to claim 43 and is rejected on the same basis.

As to claim 50, the claim is substantially similar to claim 42 and is rejected on the same basis.

As to claim 51, the claim is substantially similar to claim 36 and is rejected on the same basis.

Art Unit: 2166

As to claim 52, D'Agostino discloses the apparatus of claim 44, wherein said goods and services include financial services (col. 6, lines 30-36).

As to claim 53, D'Agostino discloses the apparatus of claim 44, wherein said goods and services include auctioning services (col. 6, lines 30-36).

As to claim 54, D'Agostino does not explicitly disclose the apparatus of claim 44, further comprising a software application for assisting the central communications facility to download a contract to the computerized remote location.

However, Dworkin discloses further comprising a software application for assisting the central communications facility to download a contract to the computerized remote location (col. 8, lines 10-24). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 44, wherein said central communications facility further or at least one of the other central communications facilities further provides a directory of providers of goods and services as taught by Dworkin within D'Agostino in order to provide a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 55, the claim is similar in scope to claim 37 and is rejected on the same basis.

Art Unit: 2166

As to claim 57, the claim is similar in scope to claim 39 and is rejected on the same basis.

As to claim 58, the claim is similar in scope to claim 40 and is rejected on the same basis.

As to claim 59, the claim is substantially similar to claim 30 and is rejected on the same basis.

As to claim 60, D'Agostino discloses the method of claim 59, further comprising establishing communication with a third database containing information relating to goods and services (see Fig. 1).

As to claims 61-63, the claims are similar in scope to claims 39-41 and are rejected on the same basis.

As to claim 67, the claim is similar in scope to claim 42 and is rejected on the same basis.

As to claim 68, the claim is similar in scope to claim 35 and is rejected on the same basis.

As to claim 69, the claim is similar in scope to claim 36 and is rejected on the same basis.

Art Unit: 2166

As to claim 70, D'Agostino discloses an apparatus for marketing goods and services (see abstract), comprising:

a central communications facility to provide information relating to goods and services to a customer at a computerized remote facility, said central communications facility adapted to enable said customer to select at least one other central communications facility providing information relating to goods and services (see Fig. 1 and col. 5, lines 64 - col. 6, line 35);

a first communication device at said central communications facility associated with a first communication path for providing live communication between the central communications facility and said computerized remote facility (col. 6, lines 17-27);

a second communication device at said central communications facility associated with a second communication path for providing simultaneous digital communication between said central communications facility and said computerized remote facility (col. 6, lines 17-27); and D'Agostino does not explicitly disclose

a database of information relating to goods and services accessible by said customer at said remote facility.

However, Dworkin discloses a database of information relating to goods and services accessible by said customer at said remote facility (col. 3, lines 60-69, col. 4, lines 35-61, and col. 5, lines 20). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the features above as taught by Dworkin within D'Agostino in

Art Unit: 2166

order to provide a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

As to claim 71, the claim is similar in scope to claim 47 and is rejected on the same basis.

As to claim 72, the claim is similar in scope to claim 42 and is rejected on the same basis.

As to claims 73-76, the claims are similar in scope to claims 39-41 and are rejected on the same basis.

13. Claims 38, 56, 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over D'Agostino and Dworkin as applied to claims 37, 56, and 65 above, and further in view of Filepp et al., Pat. No. 5,347,632.

As to claim 38, D'Agostino and Dworkin do not explicitly disclose the apparatus of claim 37, wherein said processor is further programmed to provide targeted advertising based on said customer profile.

However, Filepp discloses a computerized system that records customer preferences (i.e. responses) with respect to products offered for sale or purchased by the customer(col. 2, lines 46-50 and col. 93, lines, lines 28-43). The recorded customer responses represent the customer profile information, detailing user activity for the customer using the computerized system (col. 5,

Art Unit: 2166

lines 22-33). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the apparatus of claim 37, wherein said processor is further programmed to provide targeted advertising based on said customer profile as disclosed by Filepp within D'Agostino in order to target advertisements or product offers (i.e. information) to specific customers based on consumer marketing strategies developed from the customer profile information (col. 93, lines 39-43).

As to claims 56 and 66, the claims are similar in scope to claim 38 and are rejected on the same basis.

Double Patenting

14. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

15. Claims 30-76 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,055,514 in view of Dworkin, D'Agostino and Filepp.

Art Unit: 2166

As to claim 30, the '514 patent discloses an apparatus to market and sell goods and/or services over an electronic network (see claim 2) comprising:

a computerized central communications facility adapted to be coupled to a plurality of other computerized central communications facilities and to a network, each of said computerized central communications facilities having information relating to goods and/or services stored in a database, and each of said computerized communications facilities having a processor programmed to (see claim 1):

receive from a customer located at a computerized remote facility a request to search in the database at the computerized central communications facility for information of interest (claim 1);

provide said customer with live assistance upon request (claim 2);

enable said customer to search said database for information of interest, direct a transmitter at said computerized central communications facility to transmit said information of interest from the database at said computerized central communications facility to said computerized remote communications facility (claim 1); and

The '514 patent does not explicitly disclose

periodically update said database in said computerized central communications facility.

However, Dworkin discloses periodically update said database in said computerized central communications facility (i.e. new product information)(col. 9, lines 36-47). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the

Art Unit: 2166

features above as taught by Dworkin within the '514 patent in order to provide a system for locating and purchasing products of interest to a customer (col. 1, lines 8-12 and lines 63-65).

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Pat. No. 5,191,410 discloses an interactive television system for viewing presentations with respect to products and information being viewed.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 8:30 AM to 6:00 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached on (703) 305-9643. The fax telephone number for this group is (703) 305-0040.

Alexander Kalinowski *AK*

8/25/2001

[Signature]
TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100